

### **REMARKS**

This responds to the Office Action dated July 18, 2005, and the references cited therewith.

Claims 1, 2, 9, 12, and 16 are amended. Claims 1-19 are pending in this application.

#### **§102 Rejection of the Claims**

Claims 9, 10 and 12-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Altman (U.S. Patent No. 5,551,427).

Applicant has amended claim 9 to better describe the subject matter recited in the claim. Applicant believes amended claim 9 is not anticipated by the cited reference since the reference does not include each limitation recited in the claim. For instance, Applicant cannot find in the cited reference a lead and pulse generator system comprising: a pulse generator, an endocardial lead body including an electrode disposed along the lead body, the lead couplable to the pulse generator to deliver signals via the electrode, and an active fixation helix disposed at a distal end of the lead body, the fixation helix including a non-soluble insulating material coated on at least a portion of its surface, the insulating material including an active ingredient. In contrast, Altman discusses a conductor and/or insulator device implanted into a heart to eliminate a portion of tissue from the electrical field within the heart. (Abstract). Altman does not discuss a pulse generator and an endocardial lead coupled to the pulse generator to deliver signals.

Claims 10 and 12-15 include each limitation of claim 9 and are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

Claims 9 and 11-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Dutcher et al. (U.S. Patent No. 5,217,028).

Applicant has amended claim 9 to better describe the subject matter recited in the claim. Applicant believes amended claim 9 is not anticipated by the cited reference since the reference does not include each limitation recited in the claim. For instance, Applicant cannot find in the cited reference a lead and pulse generator system comprising: a pulse generator, an endocardial

lead body including an electrode disposed along the lead body, the lead couplable to the pulse generator to deliver signals via the electrode, and an active fixation helix disposed at a distal end of the lead body, the fixation helix including a non-soluble insulating material coated on at least a portion of its surface, the insulating material including an active ingredient. In contrast, Dutcher discusses an epicardial lead. Moreover, Dutcher discusses that a plug impregnated with a drug is located within the a recess in the head. (Abstract). Dutcher does not discuss a fixation helix including a non-soluble insulating material coated on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 9.

Claims 11-15 include each limitation of claim 9 and are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

#### §103 Rejection of the Claims

Claims 1-5 and 7-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisping (U.S. Patent No. 4,886,074).

#### Claims 1-5, 7 and 8

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant believes claim 1 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Bisping a helix including non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 1.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 2-5, 7, and 8 include each limitation of claim 1 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 9-15

Applicant has amended claim 9 to better describe the subject matter recited in the claim. Applicant believes claim 9 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Bisping a helix including a non-soluble insulating material coated on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 9.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 10-15 include each limitation of claim 9 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 16-19

Applicant has amended claim 16 to better describe the subject matter recited in the claim. Applicant believes claim 16 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Bisping, a fixation helix including a non-soluble insulating material coated on at least a portion of its outer surface so as to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 16.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 17-19 include each limitation of claim 16 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 1, 2, 3, and 7-19 were rejected under 35 USC § 103(a) as being unpatentable over Grassi (U.S. Patent No. 4,624,265).

Claims 1, 2, 3, 7 and 8

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant believes claim 1 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Grassi a helix including non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 1.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 2, 3, 7, and 8 include each limitation of claim 1 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 9-15

Applicant has amended claim 9 to better describe the subject matter recited in the claim. Applicant believes claim 9 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Grassi a helix including a non-soluble insulating material coated on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 9.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 10-15 include each limitation of claim 9 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 16-19

Applicant has amended claim 16 to better describe the subject matter recited in the claim. Applicant believes claim 16 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Grassi, a fixation helix including a non-soluble insulating material coated on at least a portion of its outer surface so as to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 16.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 17-19 include each limitation of claim 16 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 4 and 5 were rejected under 35 USC § 103(a) as being unpatentable over Grassi (U.S. Patent No. 4,624,265).

Claims 4 and 5 depend from claim 1 and are not obvious over the cited references for the reasons discussed about regarding claim 1. Reconsideration and allowance is respectfully requested.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisping (U.S. Patent No. 4,886,074) or Grassi (U.S. Patent No. 4,624,265) as applied to claim 1 above. Claim 6 depends from claim 1 and is not obvious over the cited references for the reasons discussed about regarding claim 1. Reconsideration and allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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1/18/06

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of January, 2006.

Name

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